

REMARKS

Claims 1-33 are pending in the application. Claims 1-27 have been examined and claims 28-33 have been withdrawn from consideration. By the above amendment, claims 1, 18, 25 and 26 have been amended.

Election/Restrictions

Examiner contends that the inventions of groups I and II are separately classified as 705/75 and 705/50, respectively, and thus it would have been a “serious burden” to search both groups of inventions. It is respectfully submitted that Applicant finds this unpersuasive. To begin, Examiner has cited numerous references from varying classes and subclasses, none of which are even listed in the above cited 705/75 class/subclass. Examiner cannot reasonably argue that searching two separate subclasses /75 and /50 of class 750 would be a burden, much less a serious burden, when Examiner appears to have searched numerous classes as evidenced by the references cited. Moreover, even assuming the claims of groups I and II are distinct, they have some relation with respect to using private mailboxes to confirm transactions, which seems to be the primary subject of Examiner’s current search. In such circumstances, Applicant respectfully requests that Examiner consider the claims of Groups I and II and withdraw the finality of the restriction requirement.

Claim Rejections - 35 U.S.C. § 112

Claim 26 stands rejected as being indefinite for the reasons set forth on page 3 of the Office Action. Claim 26 has been amended to provide sufficient antecedent basis. Accordingly, withdrawal of the rejection is requested.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 6-8, 10-16, 18, 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,903,878 to Talati, et al., for the reasons set forth on page 3-6 of the Office Action.

At the very minimum, claims 1 and 18 are believed to be patentably distinct and patentable over Talati as the cited reference does not disclose or suggest *wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction*, as essentially recited in claims 1 and 18. Indeed, although Talati generally discloses in the cited sections (Col. 10, lines 53-67, Col. 11, lines 2-4) using an e-mail delivery system to enable confirmation of the validity of a transaction, Talati expressly discloses that the e-mail system is used to send a purchase order from the consumer to the merchant (i.e., the purchase order is formatted and transmitted to the merchant via an e-mail message, see Col. 10, lines 46-47).

This is in stark contrast to the claimed invention *wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction*. Indeed, as explained on page 15, line 20, through page 16, line 5, of Applicant's specification, one level of authentication of a reply message is provided by virtue of the use of the private mailbox and knowledge and explicit action of the consumer. Indeed, it is difficult for unauthorized individuals to confirm a fraudulent authorization because the location of the consumer's private electronic mailbox is not communicated or agreed to during an electronic transaction and because only the authorized consumer will know the location of his/her private electronic mailbox (e.g. phone number, e-mail account/server) to access and provide confirmation.

Therefore, for at least the above reasons, claims 1 and 18 are not anticipated by, and are patentable over, the teachings of Talati. Further, claims 2, 6-8, 10-16, 22 and 23 are patentable over Talati at least by virtue of their dependence from respective base claims 1 and 18. Accordingly, the withdrawal of all the rejections under 35 U.S.C. § 102(b) is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 3-5, 19 and 20 stand rejected as being unpatentable over Talati in view of U.S. Publication No. 2001/0037464 to Persels, et al.

Claims 9 and 21 stand rejected as being unpatentable over Talati in view of U.S. Publication No. 2001/004050 to Fletcher, et al.

Claims 17 stands rejected as being unpatentable over Talati in view of U.S. Publication No. 2003/0018572 to Beschle, et al.

Claim 24 stands rejected as being unpatentable over Talati.

Each of the obvious rejections are based, in part, on the contention that Talati discloses each of the elements of claims 1 and 18 from which these claims depend. As demonstrated above, however, it is respectfully submitted that Talati does not teach or suggest the elements of claims 1 or 18. Therefore, the above combinations of references are legally deficient on their face, as none of the cited references disclose or suggest, at the very minimum, the elements of claims 1 and 18.

Furthermore, claims 25-27 stand rejected as being unpatentable over Talati in view of U.S. Publication No. 2001/004050 to Fletcher, et al. Although Applicant disagrees with the original rejection of claim 25 as set forth on pages 8-9 of the Office Action as being based on hindsight reasoning and lack of sufficient motivation for combining the reference teachings, it is clear that at

the very minimum, claim 25 is patentable and non-obvious over the combination of Talati and Fletcher because the cited combination does not disclose or suggest *wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction*, as recited in claim 25. Therefore, claim 25 (and dependent claims 26-27) are non-obvious and patentable over the cited combination.

For at least the above reasons, withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested.

Respectfully submitted,



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